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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,381	10/16/2003	Thierry Fleurence	1948-4821	2245
27123	7590	12/17/2008		
MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101				
EXAMINER				
PICKARD, ALISON K				
ART UNIT		PAPER NUMBER		
3676				
NOTIFICATION DATE		DELIVERY MODE		
12/17/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTOPatentCommunications@Morganfinnegan.com

Shopkins@Morganfinnegan.com

jmedina@Morganfinnegan.com

Office Action Summary

Application No.

10/688,381

Applicant(s)

FLEURENCE, THIERRY

Examiner

Alison K. Pickard

Art Unit

3676

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-7, 10, 11, 13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 6, 7, 10, 11, 13 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. The indicated allowability of claims 1, 6, and 7 is withdrawn in view of the newly discovered reference(s) to Hance (or Belter). Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 103

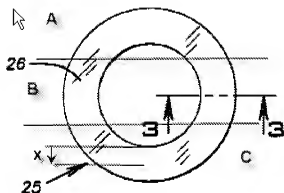
2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3, 6, 7, 10, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sylvester in view of Sellew in view of Hance (791,552).

Sylvester discloses a gasket comprising a sheet of flexible material having an orifice (figure 2). The sheet can have various materials of different hardness, a skin, and a cellular material. Sylvester does not disclose a lip on an edge of the seal. Sellew teaches a seal having flexible sheet and an orifice. Sellew teaches using a lip(s) to improve sealing particularly where there are imperfections in the mating surface (see col. 2, lines 28-39). Thus, Sellew provides a teaching of a lip at any location where improved sealing is necessary. Providing the lip(s) only at the first surface of the first side (i.e. no lip at the second surface) is considered obvious in a situation where that is the only location there may be imperfections. Or, considered a different way, even if a bead was applied to the entire perimeter/circumference of Sylvester, the claim language is met. Figure 2 of Sylvester can be divided into a top portion (A), central portion (B), and bottom portion (C) as shown below in the marked up Figure. The claim requires a second

surface at the bottom portion to have no lip. As shown below, the bottom portion can have a section considered a "second surface" (x) that would not have a lip (i.e. if lip were at the outer diameter of the ring like in Sellew).



The portion can be sectioned similarly even if two lips are provided at the outer diameter (e.g. for claim 6). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a lip on the first surface as taught by Sellew to improve sealing. Sylvester does not appear to disclose the central portion is more rigid than the top and bottom portions. Hance teaches a gasket having reinforcement in the material. Hance teaches that the reinforcement can be through out the whole body or just in a portion (such as a center portion of the gasket). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sylvester such that a reinforcement is only in the center of the gasket. The use of a known technique to improve a similar device in the same way is obvious. Regarding claim 7, the lip would be made of material 32 and would have a different hardness than the sheet comprising all materials 32, 34, 36, etc.

Regarding claim 3, Sylvester does not specifically disclose cellular EPDM. The selection of a known material based on its suitability for its intended use is not considered inventive. See

In re Leshin 125 USPQ 416 (CCPA 1960). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use cellular EPDM in the sheet.

4. Claims 11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sylvester in view of Sellew in view of Hance as applied to claims 10 and 13 above, and further in view of Johnson (5,090,713).

Sellew does not appear to disclose the lips (Fig. 6) are different heights. Johnson teaches a gasket with plural sealing lips. Johnson teaches using different heights to ensure a seal is formed even if the seal is not evenly or properly clamped between surfaces. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the lips different height to ensure a seal under all clamping forces.

Conclusion

5. Upon updating the search, the examiner discovered Hance and Belter. Both teach a gasket with different hardness regions within the gasket. Hance, for example, discloses that providing a reinforcement through-out or at least in the center is equivalent. The reinforcement could therefore be applied to just the center portion of Sylvester (e.g. section "B" in the Figure above). The examiner also maintains that Sellew teaches applying a bead only at a desired location. However, an alternate perspective has been provided above that still achieves the claim limitations even if a circumferential lip is applied. The claim language is broad enough that the bottom portion can be divided into a section that qualifies as the second surface without a lip. In other words, the claim does not define the extent of the second surface.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alison K. Pickard whose telephone number is 571-272-7062. The examiner can normally be reached on M-F (9-5).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer Gay can be reached on 571-272-7029. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alison K. Pickard/
Primary Examiner, Art Unit 3676

AP